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7 UNITED STATES DISTRICT COURT
8 WESTERN DISTRICT OF WASHINGTON
9 AT SEATTLE

10 CALIFORNIA EXPANDED
11 METAL PRODUCTS COMPANY,
12 et al.,

13 Plaintiffs,

14 v.

15 JAMES A. KLEIN, et al.,

Defendants.

CASE NO. C18-0659JLR

ORDER DENYING
DEFENDANTS' MOTION FOR
PARTIAL SUMMARY
JUDGMENT

16 **I. INTRODUCTION**

17 Before the court is Defendants James A. Klein, BlazeFrame Industries, Ltd.
18 ("BlazeFrame"), and Safti-Seal, Inc.'s ("Safti-Seal") (collectively, "Defendants") motion
19 for partial summary judgment. (Mot. (Dkt. # 72).) Plaintiffs California Expanded Metal
20 Products Company ("CEMCO") and Clarkwestern Dietrich Building Systems, LLC
21 (d/b/a ClarkDietrich Building Systems) ("ClarkDietrich") (collectively, "Plaintiffs")
22 oppose the motion. (Resp. (Dkt. # 80).) Defendants filed a reply. (Reply (Dkt. # 85).)

1 The court has considered the motion, the parties' submissions concerning the motion, the
2 relevant portions of the record, and the applicable law. Being fully advised,¹ the court
3 DENIES Defendants' motion for partial summary judgment for the reasons set forth
4 below.

5 **II. BACKGROUND**

6 This case presents a patent infringement dispute involving fire-retarding
7 head-of-wall assemblies used in commercial construction. Plaintiffs bring claims for
8 patent infringement against Mr. Klein; BlazeFrame, a Washington State corporation that
9 Mr. Klein founded in 2009; and Safti-Seal, a Washington State corporation that Mr. Klein
10 founded in 2017. (*See* Compl. (Dkt. # 1) ¶¶ 12, 48, 82-85, 95-98.) Additionally,
11 Plaintiffs bring breach of contract claims against Mr. Klein and BlazeFrame for alleged
12 violations of a settlement agreement reached in an earlier suit, and unfair competition
13 claims against Mr. Klein and Safti-Seal under § 43 of the Lanham Act, 15 U.S.C.
14 § 1125(a). (*Id.* ¶¶ 73-81, 86-94, 99-105.) Plaintiffs seek compensatory damages and
15 injunctive relief. (*Id.* ¶¶ 106(a)-(f).)

16 **A. The Patents-in-Suit**

17 Mr. Klein is the named inventor of U.S. Patents 7,681,365 ("the '365 patent"),
18 7,814,718 ("the '718 patent"), 7,866,108 ("the '108 patent"), 8,056,293 ("the '293
19 patent"), 8,136,314 ("the '314 patent"), and 8,151,526 ("the '526 patent") (collectively,

21 ¹ The parties request oral argument on Defendants' motion. (Mot. at 1; Resp. at 1.) The
22 parties have thoroughly briefed the issues in Defendants' motion, and the court has determined
that oral argument would not be of assistance in deciding the motion. *See* Local Rules W.D.
Wash. LCR 7(b)(4). Accordingly, the court DENIES the parties' requests for oral argument.

1 “the Patents”). (*See* Trojan Decl. (Dkt. # 81) ¶ 2, Ex. 1 (“’365 Patent”); *id.* ¶ 3, Ex. 2
2 (“’718 Patent”); *id.* ¶ 4, Ex. 3 (“’108 Patent”); *id.* ¶ 5, Ex. 4 (“’293 Patent”); *id.* ¶ 6, Ex. 5
3 (“’314 Patent”); *id.* ¶ 7, Ex. 6 (“’526 Patent”); *see also* Mot. at 3.) In 2012, Mr. Klein
4 assigned the Patents to BlazeFrame. (MTS Resp. (Dkt. # 82) at 2.) Currently, CEMCO
5 owns the Patents, and ClarkDietrich is the exclusive licensee of the Patents throughout
6 the United States. (Compl. ¶ 84.) Plaintiffs allege that Defendants have infringed at least
7 one claim of the ’365, ’718, ’314, and ’526 patents (collectively, “the Patents-in-Suit”).
8 (*Id.* ¶ 83.)

9 The Patents-in-Suit describe fire-retarding head-of-wall assemblies used in
10 commercial construction. (*See* Mot. at 3-4; Resp. at 3-4.) A head-of-wall assembly, also
11 referred to as a “header,” is a horizontal metal track that is mounted to a ceiling. (Mot. at
12 3.) Vertical studs are attached to headers to frame walls. (’365 Patent at 1:23-46; Resp.
13 at 3-4.) Typically, a header has two sidewalls that form an upside-down “U” shape.
14 (’365 Patent at 1:43-46; Resp. at 4.) The Patents-in-Suit all disclose a metal header with
15 a strip of intumescent material affixed to at least one sidewall. (*See* ’365 Patent; ’718
16 Patent; ’314 Patent; ’526 Patent.) When exposed to heat, the intumescent material
17 expands to fill the gap between the header and the ceiling, inhibiting the spread of smoke
18 and fire. (*See, e.g.*, ’365 Patent at 5:44-48; *see also* Mot. at 4; Resp. at 4.)

19 **B. Prior Cases**

20 This case is the third chapter of a long-running dispute among the parties. In
21 2012, CEMCO sued ClarkDietrich and Mr. Klein, its former employee, in the United
22 States District Court for the Central District of California. *See Cal. Expanded Metal*

1 *Prods. Co. v. Clarkwestern Dietrich Bldg. Sys., LLC*, No. CV12-10791-DDP-MRW
2 (C.D. Cal.).² In that case, CEMCO alleged that Mr. Klein breached a contractual
3 obligation to offer CEMCO an exclusive license to any construction products he invented
4 after leaving CEMCO. (10791 Case Compl. (Dkt. # 1) ¶¶ 6-7.) In October 2015, the
5 parties reached a settlement agreement (“the first settlement agreement”). (*See* Trojan
6 Decl. ¶ 8, Ex. 7 (1st Settlement Tr.)) Under the first settlement agreement, Mr. Klein
7 and BlazeFrame assigned the Patents to CEMCO in exchange for an upfront payment of
8 \$800,000, certain royalties, and a nonexclusive license to sell headers covered by the
9 Patents in a geographically restricted area. (1st Settlement Tr. at 9:13-10:4; *see also* Mot.
10 at 6; Resp. at 11.) Additionally, CEMCO granted ClarkDietrich a nonexclusive license to
11 the Patents in the restricted territory and an exclusive license to the Patents throughout
12 the rest of the United States. (1st Settlement Tr. at 10:9-12.)

13 In 2016, Defendants filed a second suit against Mr. Klein and BlazeFrame,
14 alleging breach of the first settlement agreement and infringement of the Patents. *See*
15 *Cal. Expanded Metal Prods. Co. v. Klein*, No. CV16-5968-DDP-MRW (C.D. Calif.);³
16 (*see also* Mot. at 6.) In June 2017, the parties reached a confidential settlement
17 agreement (“the second settlement agreement”). (*See* 5968 Case Settlement Conf. Mins.
18 (Dkt. # 119).) Shortly thereafter, the second suit was dismissed. (5968 Case 7/21/17

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² When citing the docket in Case No. CV12-10791-DDP-MRW, the court cites to the
“10791 Case.”

22 ³ When citing the docket in Case No. CV16-5968-DDP-MRW, the court cites to the
“5968 Case.”

1 Order (Dkt. # 124).) Pursuant to the second settlement agreement, Mr. Klein and
2 BlazeFrame agreed to cease selling head-of-wall products covered by the Patents sold to
3 CEMCO under the first settlement agreement. (*See* Resp. at 5; 4/2/18 JSR (Dkt. # 49) at
4 1.) Additionally, Mr. Klein and BlazeFrame sold the BlazeFrame trademarks to
5 ClarkDietrich. (Resp. at 5.) Currently, CEMCO remains the owner of the Patents, and
6 ClarkDietrich is the exclusive licensee of the Patents. (Compl. ¶ 84.)

7 **C. Factual Background**

8 **1. Safti-Seal Products**

9 Plaintiffs allege that Mr. Klein founded Safti-Seal in June 2017, while the parties
10 were negotiating a settlement in the second suit. (Compl. ¶ 48; Pl. MTS (Dkt. # 75) at 3.)
11 Mr. Klein attests that he founded Safti-Seal in September 2017. (Klein MTS Decl. (Dkt.
12 # 82-1) ¶ 4.) Safti-Seal sells fire safety products for use in commercial construction,
13 including fire-retarding head-of-wall assemblies. (Klein MSJ Decl. (Dkt. # 72-1) ¶ 16,
14 Ex. A (“12/28/17 Klein Email”).) Like a BlazeFrame head-of-wall assembly, a Safti-Seal
15 head-of-wall assembly consists of a U-shaped metal header track with outward-facing
16 sidewalls to which fire-safety strips containing intumescent material are attached. (*See*
17 Compl. ¶¶ 59, 61, 63, 65.) Unlike a BlazeFrame head-of-wall assembly, a Safti-Seal
18 head-of-wall assembly features a “foamed thermoplastic thermal barrier” between the
19 intumescent material and the metal sidewall. (Klein MSJ Decl. ¶¶ 9, 12.) Photographs of
20 BlazeFrame and Safti-Seal headers are shown below.

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BlazeFrame Header



Safti-Seal Header

(*Id.* ¶¶ 17-18, Exs. B-C.)

Plaintiffs allege that Safti-Seal headers “are covered by at least one claim of each of the ’365, ’718, ’314, and ’526 Patents,” which were sold to CEMCO as part of the first settlement agreement. (Compl. ¶ 56.) Defendants, in contrast, argue that Safti-Seal products represent “a significant design change” as compared to products covered by the Patents-in-Suit. (Mot. at 14.)

Mr. Klein emphasizes that he designed Safti-Seal headers to comply with updated safety standards set by a testing agency called Underwriter Laboratories (“UL”). (Klein MSJ Decl. ¶¶ 8-9.) He states that after “test[ing] dozens of variations and configurations of header tracks in combination with different materials, at home, in [his] garage,” he decided to “separate [the intumescent material] from the header track with a foamed thermoplastic thermal barrier.” (*Id.* ¶ 9.) According to Mr. Klein, the thermal barrier increases the time needed for heat to penetrate a wall and ensures that Safti-Seal headers pass the UL safety standards currently in effect. (*Id.* ¶¶ 11, 15.) Mr. Klein avers that “to the best of [his] knowledge,” the products covered by the Patents-in-Suit do not satisfy the updated UL standards. (*Id.* ¶ 8.)

1 2. Claim at Issue

2 Claim 1 of the '526 patent is illustrative of the claims of the Patents-in-Suit
3 alleged to be infringed. (*See* Mot. at 12-13 (setting forth Claim 1 of the '526 patent);
4 Resp. at 13.) The claim recites:

5 1. A fire-retardant head-of-wall assembly, comprising:

6 an elongated sheet-metal footer track;

7 an elongated sheet-metal header track confronting and vertically spaced apart
8 from the footer track, the header track including a web integrally
9 connected to a pair of spaced apart and downwardly extending sidewalls,
10 each sidewall having an upper sidewall portion adjacent to the web and a
11 lower sidewall portion;

12 an elongated intumescent strip affixed lengthwise on at least one of the outer
13 sidewall surfaces of the pair of sidewalls, the intumescent strip being
14 positioned on the upper sidewall portion;

15 ('526 Patent at 7:33-44; *see also* '365 Patent at 6:43-62; '718 Patent at 10:10-29; '314
16 Patent at 10:21-33.) With respect to the motion before the court, the parties' dispute
17 centers on the limitation that claims "an elongated intumescent strip affixed lengthwise
18 on at least one of the outer sidewall surfaces of the pair of sidewalls." ('526 Patent at
19 7:41-44; '365 Patent at 6:57-59; *see also* '718 Patent at 10:23-25 (claiming "an elongated
20 heat expandable intumescent strip affixed lengthwise on at least one of the outer sidewall
21 surfaces of the pair of sidewalls"); '314 Patent at 10:26-28 (same)).

22 3. The Klein Email

23 On December 28, 2017, Mr. Klein emailed a "[y]ear end update" to an unspecified
24 audience. (12/28/17 Klein Email; *see also* Compl. ¶ 70, Ex. 4 ("Undated Klein Email").)

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1 The subject line of Mr. Klein’s email read, “Product Advancement and Name Change.”
2 (12/28/17 Klein Email.) Mr. Klein began the email by introducing Safti-Seal:

3 BlazeFrame Ltd. will no longer exist after year end as we have moved all of
4 our products and newly “advanced joint seal protection” Safti-Frame and
Safti-Strip (certified to newest UL 2079 v.5 standards with no additional post
5 drywall requirements) under new Safti-Seal Inc.

6 BlazeFrame name and original product design have been sold off to others
7 and for life safety design considerations.....products now referred to as
8 BlazeFrame (appear similar to other systems) under current UL 2079 v.5 test
9 standards now require additional post drywall installed “Stuffed Foam
10 Backer/Mud and Tape coating” or “Stapled on Perimeter L-Bead (Foam)”
11 installed over or in joints creating new encumbered and limited deflection,
12 installation, and specification considerations.... (refer to UL listings).

13 (*Id.* (emphases and ellipses in original).) Mr. Klein then offered additional information
14 about Safti-Seal products. (*Id.*) He closed the email by providing a link to Safti-Seal’s
15 website and his contact information “for future assistance and orders.” (*Id.*)

16 Plaintiffs claim that Mr. Klein’s email contained misleading statements intended
17 to damage the “goodwill” ClarkDietrich has developed in the BlazeFrame trademarks and
18 products covered by the Patents. (Compl. ¶ 101.) Specifically, Plaintiffs contend that,
19 “[b]y asserting falsely in a broadly published email that ‘the BlazeFrame name and
20 original product have been sold off to others’ for ‘life safety design consideration,’ Klein
21 or Safti-Seal have misrepresented the nature, characteristics, and qualities of
22 ClarkDietrich’s BlazeFrame products.” (*Id.* ¶ 100.)

23 **D. Procedural History**

24 In January 2018, Plaintiffs filed suit in the United States District Court for the
25 Central District of California against Mr. Klein, BlazeFrame, and Safti-Seal, alleging

1 patent infringement, breach of contract, and unfair competition. (*See id.* at ¶¶ 73-105.)
2 On April 30, 2018, the Honorable Dean D. Pregerson, United States District Judge,
3 transferred this action to the Western District of Washington pursuant to *TC Heartland,*
4 *LLC v. Kraft Foods Grp.*, 137 S. Ct. 1514 (2017). (4/30/18 Order (Dkt. # 51).) On
5 August 2, 2018, the court issued a scheduling order setting trial and related dates. (8/2/18
6 Min. Order (Dkt. # 79).) A *Markman* hearing is scheduled for March 22, 2019. (*Id.* at
7 2.)

8 Defendants move for summary judgment on three grounds. (*See Mot.*) First,
9 Defendants contend that because Plaintiffs' complaint makes "no allegations about or
10 reference to the '108 or '293 patents," the court must "dismiss[]" any claims of
11 infringement with respect to the '108 and '293 patents. (*Id.* at 8.) Second, Defendants
12 assert that they are entitled to summary judgment of non-infringement of the
13 Patents-in-Suit. (*Id.* at 9.) Finally, Defendants argue that "Plaintiffs' claim for unfair
14 competition . . . must be dismissed because [Plaintiffs] cannot prove [that Defendants
15 committed] a false or deceptive act" implicating Plaintiffs' products. (*Id.* at 20-21.) The
16 court now turns to Defendants' motion.

17 **III. DISCUSSION**

18 **A. Summary Judgment Standard**

19 Summary judgment is appropriate if the evidence shows "that there is no genuine
20 dispute as to any material fact and the movant is entitled to judgment as a matter of law."
21 Fed. R. Civ. P. 56(a); *see Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986); *Galen v.*
22 *Cty. of L.A.*, 477 F.3d 652, 658 (9th Cir. 2007). A fact is "material" if it might affect the

1 outcome of the case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A
2 factual dispute is “‘genuine’ only if there is sufficient evidence for a reasonable fact
3 finder to find for the non-moving party.” *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986,
4 992 (9th Cir. 2001) (citing *Anderson*, 477 U.S. at 248-49).

5 The moving party bears the initial burden of showing there is no genuine dispute
6 of material fact and that it is entitled to prevail as a matter of law. *Celotex*, 477 U.S. at
7 323. If the moving party does not bear the ultimate burden of persuasion at trial, it can
8 show the absence of such a dispute in two ways: (1) by producing evidence negating an
9 essential element of the nonmoving party’s case, or (2) by showing that the nonmoving
10 party lacks evidence of an essential element of its claim or defense. *Nissan Fire &*
11 *Marine Ins. Co. v. Fritz Cos.*, 210 F.3d 1099, 1106 (9th Cir. 2000). If the moving party
12 meets its burden of production, the burden then shifts to the nonmoving party to identify
13 specific facts from which a fact finder could reasonably find in the nonmoving party’s
14 favor. *Celotex*, 477 U.S. at 324; *Anderson*, 477 U.S. at 250.

15 The court is “required to view the facts and draw reasonable inferences in the light
16 most favorable to the [nonmoving] party.” *Scott v. Harris*, 550 U.S. 372, 378 (2007)
17 (internal quotation marks and citation omitted). The court may not weigh evidence or
18 make credibility determinations in analyzing a motion for summary judgment because
19 those are “jury functions, not those of a judge.” *Anderson*, 477 U.S. at 255.
20 Nevertheless, the nonmoving party “must do more than simply show that there is some
21 metaphysical doubt as to the material facts Where the record taken as a whole could
22 not lead a rational trier of fact to find for the nonmoving party, there is no genuine issue

1 for trial.” *Scott*, 550 U.S. at 380 (internal quotation marks omitted) (quoting *Matsushita*
2 *Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586-87 (1986)). Accordingly,
3 “mere allegation and speculation do not create a factual dispute for purposes of summary
4 judgment.” *Nelson v. Pima Cmty. Coll.*, 83 F.3d 1075, 1081-82 (9th Cir. 1996).

5 **B. The ’108 and ’293 Patents**

6 Defendants argue that they are entitled to summary judgment of non-infringement
7 of the ’108 and ’293 patents. (Mot. at 8.) According to Defendants, “although the
8 [c]omplaint defines the ’108 and ’293 patents as being in suit, and its prayer requests
9 relief for alleged infringement, they are subject to dismissal under . . . Rule 56 of the
10 Federal Rules of Civil Procedure because the [c]omplaint makes *no* allegations about
11 them.” (*Id.*) Plaintiffs respond that the complaint makes no allegations about the ’108 or
12 ’293 patents because these patents are not alleged to be infringed. (Resp. at 11.)
13 Plaintiffs state that, “[t]o the extent that the Prayer for Relief refers generally to ‘the
14 Patents,’ which might be misconstrued to include the ’108 or ’293 Patents, any implied
15 reference to the ’108 or ’293 Patents is inadvertent.” (*Id.*)

16 The court finds that Plaintiffs assert no claims with respect to the ’108 and ’293
17 patents. Plaintiffs expressly refer to the ’108 and ’293 patents one time in the complaint,
18 when identifying the various patents relating to fire-blocking devices of which Mr. Klein
19 is the named inventor. (Compl. ¶ 10.) As Defendants note, the complaint collectively
20 refers to the Patents-in-Suit as well as the ’108 and ’293 patents as “the Patents.” (*Id.*;
21 *see also* Mot. at 8.) Yet aside from a passing reference in the prayer for relief to
22 “products that infringe any claim of any of the Patents” (Compl. ¶ 106(c)), Plaintiffs refer

1 to “the Patents” only when describing the patents that Mr. Klein and BlazeFrame sold
2 CEMCO under the first settlement agreement (*id.* ¶¶ 18-23; *see also* Resp. at 11). At no
3 point do Plaintiffs suggest that the ’108 and ’293 patents are in-suit here. (*See generally*
4 Compl.) Indeed, in setting forth their patent infringement claims, Plaintiffs expressly
5 allege infringement only of “the ’365, ’718, ’314, and ’526 Patents.”⁴ (Compl. ¶¶ 83, 86;
6 *see also* ¶¶ 56-57.)

7 Because Plaintiffs do not assert any claim involving the ’108 or ’293 patents, there
8 is no controversy concerning these patents over which the court may exercise
9 jurisdiction. *See, e.g., Susan B. Anthony List v. Driehaus*, 134 S. Ct. 2334, 2341 (2014)
10 (“Article III of the Constitution limits the jurisdiction of federal courts to ‘Cases’ and
11 ‘Controversies.’”). Accordingly, the court DENIES Defendants’ motion for summary
12 judgment with respect to the ’108 and ’293 patents.⁵

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14 ⁴ In their reply, Defendants note that Plaintiffs filed a report with the U.S. Patent and
15 Trademark Office stating that “a court action has been filed . . . on” the Patents-in-Suit and the
16 ’108 and ’293 patents. (Reply at 2; *see also* Rep. to U.S. PTO (Dkt. # 6) at 1.) As discussed
17 above, however, the pleadings before the court do not identify the ’108 and ’293 patents as being
in-suit, and the court lacks jurisdiction to enter judgment over claims not before it. To the extent
the disjunction between Plaintiffs’ complaint and Plaintiffs’ report to the Patent and Trademark
Office reflects careless reporting, the court cautions Plaintiffs be more precise going forward.

18 ⁵ Defendants also assert that Plaintiffs’ claims of infringement of the ’108 and ’293
19 patents “are subject to dismissal under [Federal] Rule [of Civil Procedure] 12(b)(6)” for failure
20 to state a claim upon which relief can be granted. (Mot. at 8.) Under Rule 12(b), a motion to
21 dismiss for failure to state a claim must be filed “before pleading if a responsive pleading is
22 allowed.” Fed. R. Civ. P. 12(b). Defendants filed their answer on May 25, 2018. (Answer (Dkt.
68).) Therefore, to the extent Defendants bring a motion to dismiss under Rule 12(b)(6), their
motion is “untimely.” *Elvig v. Calvin Presbyterian Church*, 375 F.3d 951, 955 n.2 (9th Cir.
2004) (quoting *Augustine v. United States*, 704 F.2d 1074, 1075 n.3 (9th Cir. 1983)). A court
may treat an untimely 12(b)(6) motion as a motion for judgment on the pleadings under Rule
12(c). *See* Fed. R. Civ. P. 12(h)(2); *Aldabe v. Aldabe*, 616 F.2d 1089, 1093 (9th Cir. 1980). The
standard for demonstrating that a complaint fails to state a claim upon which relief can be

1 **C. Non-Infringement of the Patents-in-Suit**

2 Defendants move for summary judgment of non-infringement of the
3 Patents-in-Suit on the grounds that Plaintiffs cannot prove direct infringement or
4 infringement under the doctrine of equivalents. (Mot. at 12-19.) According to
5 Defendants, “[t]he sole issue presented by this [m]otion as to infringement of the ’365,
6 ’718, ’314, and ’526 Patents is whether, in the accused products, an intumescent strip is
7 ‘on’ the surface of a metal header track (as the patents’ claim limitations require) or
8 whether it is not on the metal header track (and therefore lacks a limitation that the
9 patents’ claims require).” (*Id.* at 9.)

10 To determine whether a particular product infringes an existing patent, the court
11 engages a two-step analysis. First, the court must identify, as a matter of law, the proper
12 construction of the asserted patent claim. *Markman v. Westview Instruments, Inc.*, 517
13 U.S. 370, 384-91 (1996). After the claim has been properly construed, the factfinder
14 determines whether the accused device infringes the claim. *See, e.g., O.I. Corp. v.*
15 *Tekmar Co., Inc.*, 115 F.3d 1576, 1580 (Fed. Cir. 1997).

16 In patent infringement cases, summary judgment is appropriate when it is apparent
17 that a reasonable jury could reach only one conclusion as to infringement. *See Telemac*
18 *Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1323 (Fed. Cir. 2001) (citing *ATD*
19 *Corp. v. Lydall, Inc.*, 159 F.3d 534, 540 (Fed. Cir. 1998)); *U.S. Phillips Corp. v. Iwasaki*

20
21 granted is the same under both rules. *See, e.g., Otter v. Northland Grp., Inc.*, No.
22 C12-2034RSM, 2013 WL 2243874, at *1 (W.D. Wash. May 21, 2013). Construing Defendants’
12(b)(6) motion as a motion for judgment on the pleadings, the court denies the motion for the
reasons stated above. *See supra* § III.B.

1 *Elec. Co. Ltd.*, 505 F.3d 1371, 1374-75 (Fed. Cir. 2007) (“Summary judgment on the
2 issue of infringement is proper when no reasonable jury could find that every limitation
3 recited in a properly construed claim either is or is not found in the accused device either
4 literally or under the doctrine of equivalents.”).

5 At the outset, the court draws attention to its standing order on patent cases. (*See*
6 *Standing Order on Patent Cases*, Judge James L. Robart Chambers Procedures,
7 <http://www.wawd.uscourts.gov/judges/robart-procedures>.) Pursuant to the standing
8 order, “[t]he court will not rule on dispositive motions that raise issues of claim
9 construction prior to the *Markman* hearing, unless special circumstances warrant and the
10 party obtains leave of court in advance of filing.” (*Id.* at 2; *see also* 8/2/18 Min. Order at
11 2.) Other courts are similarly reluctant to entertain motions for summary judgment that
12 prematurely raise issues of claim construction. *See, e.g., Zipit Wireless, Inc. v.*
13 *Blackberry Ltd.*, No. 6:13-cv-02959-JMC, 2016 WL 5933975, at *9 (D. S.C. Oct. 12,
14 2016) (noting that “summary judgment prior to the issuance of the court’s
15 claim-construction order tends to shortchange the proper development of the case”);
16 *Stratasys, Inc. v. Microboards Tech., LLC*, No. 13-3228 (DWF/TNL), 2014 WL
17 5438396, at *2 (D. Minn. Oct. 22, 2014) (denying as premature the defendant’s motion
18 for summary judgment on the issue of infringement because the motion was filed prior to
19 claim construction proceedings).

20 Defendants argue that resolution of the instant motion does not require claim
21 construction. (Mot. at 10.) As an initial matter, Defendants assert that in both this action
22 and the prior suits, Plaintiffs have consistently maintained that no claim term in any of

1 the asserted patents requires construction. (*Id.*) Defendants identify three representations
2 by Plaintiffs that purportedly illustrate Plaintiffs’ “about-face” on the necessity of claim
3 construction (Mot. at 10): (1) a joint status report in this case, filed before transfer to the
4 Western District of Washington, in which Plaintiffs declined to propose a date for a
5 *Markman* hearing (4/2/18 JSR at 2); (2) a March 28, 2018, email from CEMCO’s counsel
6 to Defendants’ counsel expressing the position that “a *Markman* hearing [would] be
7 unnecessary due to Judge Pregerson’s familiarity with this case and the relative simplicity
8 of the technology at issue” (Bageant MSJ Decl. (Dkt. # 72-2) ¶ 2, Ex. 1 (“Wong Email”)
9 at 4); and (3) a prehearing statement in the second suit, in which Plaintiffs suggested a
10 *Markman* hearing was not warranted (Prehr’s Stmt. (C16-5988 Dkt. # 97) at 2-3).

11 The court is not persuaded that Plaintiffs’ previous positions on the propriety of a
12 *Markman* hearing somehow preclude Plaintiffs from asserting that the motion before the
13 court raises issues of claim construction. As the Federal Circuit has recognized, parties in
14 patent infringement suits often hold evolving views on the necessity of claim
15 construction. *See, e.g., TNS Media Research, LLC v. Tivo Research & Analytics, Inc.*,
16 629 F. App’x 916, 938-39 (Fed. Cir. 2015) (“[P]arties in patent cases frequently stipulate
17 to a construction or the court construes a term, only to have their dispute evolve to a point
18 where they realize that a further construction is necessary.”) (alteration in original).
19 Moreover, Defendants’ motion takes Plaintiffs’ representations out of context. In the
20 email to Defendants’ counsel, CEMCO’s counsel expressly raised the possibility that
21 claim construction would be warranted at the summary judgment phase, even as he
22 suggested a *Markman* hearing was unnecessary. (Wong Email at 4.) And in the

1 prehearing statement filed in the second suit, Plaintiffs suggested that claim construction
2 was not necessary in light of the court’s decision to dismiss Defendants’ patent invalidity
3 defense in that case. (Prehr’g Stmnt. at 3; *see also* Resp. at 10.) The court thus rejects
4 Defendants’ contention that Plaintiffs’ “prior statements” on the propriety of a *Markman*
5 hearing render “irrelevant” their arguments in favor of claim construction here. (Reply at
6 5.)

7 Defendants further argue that claim construction is not warranted under a
8 “plain-language application” of the terms of the Patents-in-Suit. (Reply at 4; *see also*
9 Mot. at 10-11.) In Defendants’ view, the motion “is based upon the single, dispositive
10 fact that the surface of the metal header track in Defendants’ products does not have
11 intumescent material ‘on’ it, as the patents require.” (Mot. at 10.) Defendants assert that
12 the word “on” does not require special construction: “there is no colorable argument that
13 ‘on’ the ‘surface’ means anything other than ‘on,’ or ‘in contact with.’” (*Id.* at 10-11.)
14 Defendants contend that summary judgment of non-infringement is appropriate because a
15 Safti-Seal head-of-wall assembly does not feature an intumescent strip on the surface of
16 the header; rather, “the intumescent strip is placed on a white thermal barrier, and the
17 *thermal barrier*, in turn, is placed on the surface of the header.” (*Id.* at 13; *see also* Reply
18 at 1.)

19 Plaintiffs respond that Defendants’ motion implicates at least two disputed terms
20 that require claim construction: “intumescent strip” and “affixed . . . on,” terms that
21 appear in Claim 1 of each Patent-in-Suit. (Resp. at 12; *see also* ’365 Patent; ’718 Patent;
22 ’314 Patent; ’526 Patent.) Plaintiffs first contend that, as disclosed by the specifications

1 of the Patents-in-Suit, the limitation “intumescent strip” encompasses not only
2 intumescent material but also other constituent non-intumescent materials. (*Id.* at 13-14.)
3 Under this construction, the thermal barrier found in Safti-Seal headers would constitute
4 part of the claimed intumescent strip. (*Id.* at 15.) Additionally, Plaintiffs argue that
5 Defendants’ reading of “on” is at odds with intrinsic evidence. (*Id.* at 16.) In Plaintiffs’
6 view, the term “affixed . . . on” does not require that the intumescent material be directly
7 “in contact with” the surface of the header sidewall, and necessarily covers embodiments
8 in which an adhesive backing or other material is interposed between the intumescent
9 material and the outer sidewall. (*Id.* at 16-17.)

10 The court finds that Defendants’ motion raises issues of claim construction not
11 appropriate for resolution at this time. Defendants have provided the court their own
12 construction of the term “on.” Yet neither Defendants’ reading of the Patents-in-Suit nor
13 the record currently before the court allows the court to conclusively establish the
14 meaning and scope of “affixed . . . on” and “intumescent strip,” terms that are critical to
15 Defendants’ contentions of non-infringement. *See, e.g., Trading Techs. Int’l v. eSpeed,*
16 *Inc.*, 595 F.3d 1340, 1351 (Fed. Cir. 2010) (“[C]laim construction involves many
17 technical, scientific, and timing issues that require full examination of the evidence and
18 factual resolution of any disputes before setting the meaning of the disputed terms.”).
19 Accordingly, the court concludes that formal claim construction is warranted before it
20 can consider the parties’ contentions concerning infringement. The court thus DENIES
21 Defendants’ motion for partial summary judgment of non-infringement without prejudice
22 to its renewal after claim construction.

1 **D. Lanham Act Claim**

2 Defendants move for summary judgment on Plaintiffs' claim for unfair
3 competition under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). (Mot. at 20.)
4 Defendants assert that Plaintiffs have adduced no facts that show that Defendants made a
5 false or misleading statement of fact in connection with Plaintiffs' products. (Mot. at
6 20-21.)

7 In relevant part, 15 U.S.C. § 1125(a)(1), provides a civil cause of action against:

8 (1) [a]ny person who, on or in connection with any goods or services . . . uses
9 in commerce any word, term, name, symbol, or device, or any combination
10 thereof, or any false designation of origin, false or misleading description of
11 fact, or false or misleading representation of fact, which—

12 (A) is likely to cause confusion, or to cause mistake, or to deceive as
13 to the affiliation, connection, or association of such person with
14 another person, or as to the origin, sponsorship, or approval of his or
15 her goods, services, or commercial activities by another person, or

16 (B) in commercial advertising or promotion, misrepresents the nature,
17 characteristics, qualities, or geographic origin of his or her or another
18 person's goods, services, or commercial activities[.]

19 15 U.S.C. § 1125(a). The two prongs of § 1125(a)(1) support different causes of action.
20 *See Jack Russell Terrier Network of N. Ca. v. Am. Kennel Club, Inc.*, 407 F.3d 1027,
21 1037 (9th Cir. 2005). The “false association” prong, § 1125(a)(1)(A), pertains to
22 allegations of “deceptive use of a trademark or its equivalent.” *Id.* In contrast, the “false
advertising” prong, § 1125(a)(1)(B), applies to allegations of misrepresentation about the
product itself. *Jack Russell Terrier*, 407 F.3d at 1037; *see also A.H. Lundberg Assocs.,*
Inc. v. TSI, Inc., No. C14-1160JLR, 2014 WL 5365514, at *2 (W.D. Wash. Oct. 21,
2014).

1 Although the complaint alleges facts tending to support a claim for false
2 advertising, Plaintiffs do not specify the theory of liability under which they intend to
3 proceed. (*See* Compl. ¶¶ 99-105.) Given the basis of Defendants’ motion, however, the
4 court need not probe the precise nature of Plaintiffs’ claim; Defendants move for
5 summary judgment on the ground that Plaintiffs cannot show that Defendants made any
6 false or misleading representation of fact, an element common to all claims under
7 § 1125(a). (*See* Mot. at 20-21); 15 U.S.C. § 1125(a).

8 To demonstrate falsity under the Lanham Act, “a plaintiff may show that the
9 statement was literally false, either on its face or by necessary implication, or that the
10 statement was literally true but likely to mislead or confuse consumers.” *Southland Sod*
11 *Farms v. Sover Seed Co.*, 108 F.3d 1134, 1139 (9th Cir. 1997); *see also* *Cook, Perkiss &*
12 *Liehe, Inc. v. N. Cal. Collection Serv., Inc.*, 911 F.2d 242, 245 (9th Cir. 1990) (stating
13 that a cause of action under the Lanham Act “is not limited to literal falsehoods,” but
14 rather “extends to false representations made by implication or innuendo”). Where a
15 defendant in a Lanham action is shown to have “intentionally misled consumers,” a court
16 should “presume [that] consumers were in fact deceived,” and the defendant bears the
17 burden of demonstrating otherwise. *William H. Morris Co. v. Group W, Inc.*, 66 F.3d
18 255, 258 (9th Cir. 1995).

19 Whether a particular statement is false or misleading under the Lanham Act is a
20 question of fact. *Newcal Indus., Inc. v. Ikon Office Sol.*, 513 F.3d 1038, 1053 (9th Cir.
21 2008). Accordingly, summary judgment is not appropriate where there are genuine
22 disputes of material fact as to whether the defendant made a statement that was literally

1 false or misled, confused, or deceived consumers. *See, e.g., Southland Sod Farms*, 108
2 F.3d at 1144-45 (reversing summary judgment where a reasonable juror could conclude
3 that the defendant’s advertisements were literally false). Where a plaintiff’s theory of
4 recovery is premised upon a claim of implied falsehood, “[i]t is not for the judge to
5 determine, based solely upon his or her own intuitive reaction, whether the advertisement
6 is deceptive.” *Johnson & Johnson * Merck Pharms. Co. v. Smithkline Beecham Corp.*,
7 960 F.2d 294, 297 (2d Cir. 1992).

8 Plaintiffs’ Lanham Act claim focuses on Mr. Klein’s email concerning Safti-Seal.
9 Specifically, Plaintiffs argue that consumers are likely to be misled by the following
10 phrase: “BlazeFrame name and original product design have been sold off to others and
11 for life safety design considerations” (*See* Compl. ¶¶ 99-102; *see also* Resp. at 24
12 (quoting 12/28/17 Klein Email).) In moving for summary judgment, Defendants assert
13 that Plaintiffs’ complaint “torture[s]” the language of Mr. Klein’s email. (Mot. at 21.)
14 According to Defendants, the Klein email “truthfully” stated that the BlazeFrame
15 trademark and products “have been sold off to others” and that BlazeFrame products do
16 not satisfy current UL standards. (*Id.*) Plaintiffs oppose summary judgment on the
17 ground that the phrase in the email concerning “life safety design considerations” is at
18 least ambiguous, given the placement of the ellipses and absence of “punctuation or other
19 break in the entire statement.” (Resp. at 24.) Plaintiffs also suggest that the parties’
20 dispute over the meaning of the email illustrates the need for further discovery. (*Id.* at
21 23-24.)

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1 The court concludes that genuine issues of material fact preclude summary
2 judgment on Plaintiffs' unfair competition claim. To begin, the court cannot with any
3 degree of confidence discern the meaning of the disputed statements in Mr. Klein's
4 email, much less conclude that no reasonable factfinder could find that those statements
5 were not literally false or did not mislead or confuse consumers. The email's unorthodox
6 phrasing and punctuation render the disputed statements ambiguous, and necessitate a
7 fact-intensive inquiry about the statements' veracity and whether they confused or misled
8 consumers. Moreover, the court finds that Plaintiffs' Lanham Act claim implicates
9 questions of fact as to Mr. Klein's intent, a matter not suitable for disposition on
10 summary judgment. *See, e.g., j2 Global Commc'ns, Inc. v. Zilker Ventures, LLC*, No. CV
11 08-07470 SJO (AJWx), 2009 WL 10671792, at *6 (denying the defendant's motion for
12 summary judgment on a Lanham Act claim because "[t]he intent behind [the defendant's]
13 allegedly false and misleading statements is a question of fact that is not appropriate for
14 resolution on summary judgment"); *Newcal Indus.*, 513 F.3d at 1054 (holding that the
15 district court properly denied the defendant's motion to dismiss where the statement at
16 issue appeared facially true but "there remain[ed] a factual question of whether the
17 statement was intentionally misleading at the time it was made").

18 Finally, the court notes that the parties have put before the court two subtly
19 different versions of the email at issue: the second paragraph of the email provided in
20 support of Defendants' motion for summary judgment contains a phrase about
21 BlazeFrame that does not appear in the second paragraph of the email Plaintiffs offer

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1 alongside their complaint. (*Compare* 12/28/17 Klein Email, *with* Undated Klein Email.⁶)
2 The copies of the emails also bear different timestamps. (*Id.*) Nonetheless, the parties
3 refer to “the email” as if there were only one communication at issue, and fail to address
4 the significance, if any, of the discrepancies observed here. (*See, e.g.,* Mot. at 21; Resp.
5 at 24.) The parties’ briefing and the evidentiary record generally provide an inadequate
6 basis on which the court might grant summary judgment. *See, e.g., Doe v. Abingdon*
7 *Friends Sch.*, 480 F.3d 252, 257 (3d Cir. 2007) (“[B]y its very nature, the summary
8 judgment process presupposes the existence of an adequate record.”); *Omega Morgan,*
9 *Inc. v. Heely*, No. C14-0556RSL, 2015 WL 1954653, at *4 (W.D. Wash. Apr. 29, 2015)
10 (denying summary judgment as to a claim “based on the incomplete record”).⁷ The court
11 therefore DENIES Defendants’ motion for summary judgment on Plaintiffs’ Lanham Act
12 claim.

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17 ⁶ In the complaint, Plaintiffs allege that the Undated Klein Email—appended as Exhibit 4
18 to the complaint—was sent on December 26, 2017. (Compl. ¶ 70.) No date appears on the
19 email, however (*see* Undated Klein Email), and Plaintiffs cite no other evidence concerning the
email’s date (*see generally* Compl.).

20 ⁷ Although Plaintiffs insist that their Lanham Act claim requires “further discovery”
21 (Resp. at 24), they failed to file an affidavit under Federal Rule of Civil Procedure 56(d) (*see*
22 *generally* Dkt.). Under Rule 56(d), a court may deny summary judgment when a nonmoving
party demonstrates that it cannot present facts essential to its opposition without further
discovery. *See* Fed. R. Civ. P. 56(d). Notwithstanding the absence of a Rule 56(d) motion,
summary judgment is not warranted for the reasons stated above. *See supra* § III.D.

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Dated this 20th day of November, 2018.

The Honorable James L. Robart
U.S. District Court Judge